

Application No.: 09/517,366
Response to OA of 08/2/05

Remarks

In the present response, claims 21 – 30 and 38-40 are amended. Claims 1 – 40 are presented for examination.

I. Claim Rejections: 35 USC § 101

Claims 21-30 and 38-40 are rejected under 35 USC § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse.

Claims 21 – 30 are amended to recite the following preamble: "A computer readable medium having instructions for causing a computer to execute a method, comprising." The Federal Circuit has expressly allowed this preamble, see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

For at least these reasons, claims 21-30 and 38-40 are patentable and proper under 35 USC § 101 as being directed to non-statutory subject matter.

The Office Action argues that claims 21-30 and 38-40 are directed to non-patentable subject matter because Applicants' specification states that a computer readable medium includes a piece of paper. Applicants respectfully argue that the Examiner is not properly applying the law.

Under 35 USC § 101, patentable subject matter must have two basic criteria. First, the subject matter must be one of processes, machines, manufacturers, and compositions of matter. Generally, three categories are not included as patentable subject matter: (1) abstract ideas, (2) laws of nature, and (3) natural phenomena. Second, the subject matter to be patented must be "useful." Applicants' claimed subject matter meets both of these criteria.

First, claims 21-30 and 38-40 are directed to a computer readable medium. The courts have repeatedly held that computer readable medium are statutory subject matter according to 35 USC § 101. In fact, the Court of Appeals held that "Beauregard" type preambles are acceptable (see *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)). Second, claims 21-30 and 38-40 are useful within the meaning of 35 USC § 101.

In short, claims 21-30 and 38-40 meet the requirements of 35 USC § 101.

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The Office Action contends that since Applicants' specification states that a computer readable medium includes a piece of paper, claims 21-30 and 38-40 are directed to non-statutory subject matter. This argument is improper. The Examiner is improperly reading limitations from the specification into the claims. Further, the Examiner is not properly applying the law of 35 USC § 101. As noted above, claims 21-30 and 38-40 meet the legal requirements of Section 101. Applicants respectfully remind the Examiner of the Patent Office's own guidelines for software cases (see, *Examination Guidelines for Computer-Related Inventions*). The Examiner has not followed these guidelines in rejecting the claims under Section 101.

II. Allowable Subject Matter

Applicants sincerely thank the Examiner for allowing claims 1-20 and 31-37.

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CONCLUSION

In view of the above, Applicants believe all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,



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CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 13 day of October, 2005.

By



Name: Carrie McKerley